

I. Present Status of the Claims

Claims 23, 2, 3, 7, 8, 24-27 and 29-31 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Grossman et al. (US 5,907,321) in view of Tsuria (US 5,786,845), Picco et al. (US 6,029,045), and Howe et al. (US 5,892,508).

Claims 5, 32, and 33 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Grossman in view of Tsuria, Picco, Howe and Nathan et al. (US patent no. 6,182,126).

Claim 28 stands rejected under 35 USC 103(a) as allegedly being unpatentable over Grossman in view of Tsuria, Picco, Howe and Kitsukawa et al. (US patent no. 6,282,713).

II. The combination of Grossman and Tsuria does not yield the present invention.

Grossman is directed to a scheme for enabling a cable subscriber to allow the display of advertisements during an interchannel interval (ICI). Tsuria is directed to an interval message provider operative to display predetermined information messages during channel change events. Arguably therefore, these references are in an analogous art. Nevertheless, the combination of these references fails to yield the present invention. In particular, the combination of Grossman and Tsuria would fail to teach or suggest downloading selected data sets according to user profile information and/or an interactive session in which case the display of data stream information is delayed until termination of the interactive transaction session or expiration of a predetermined period of inactivity by a user as recited in claims 23 and 31. Hence, claims 23 and 31, and their respective dependent claims are patentable over this combination of references.

III. There is no suggestion or motivation to combine Picco, directed at permitting a broadcaster to deliver localized content to be inserted into the programming data, with Grossman and/or Tsuria, each directed at schemes for displaying information during ICIs or channel changing intervals.

Because neither Grossman nor Tsuria disclose the downloading of selected data sets according to user profile information, the Office Action suggests the combination of these references with Picco. However, to establish a *prima facie* case of obviousness, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Therefore, to determine whether this combination is proper, the source

of the suggestion or motivation to combine the references must be established. If the suggestion or motivation to combine Picco and Grossman is dictated solely by the present invention, such combination is improper. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (holding that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure).

Although all of the references discuss applying transmitted advertising information to a television receiver display (see, e.g., Grossman, 1: 8-13; Tsuria, 1:62-67, Picco, Fig.1, 4: 66-67, 5: 1-22), Picco is in fact directed at a problem that is wholly unrelated to that discussed by Grossman. Indeed, the problem addressed by Picco and the problem addressed by Grossman are manifested during mutually exclusive circumstances. For example, Picco allows individualized local content to be inserted into the programming data stream (Picco, Abstract; 3: 43-62; 6: 20-23, 38-40), i.e., while a user is viewing a selected channel. In contrast, Grossman discloses the display of visual images when a user changes the channels, during a delay between the displays of sequentially displayed channels (Grossman 3: 41-55). It is this latter circumstance that is also addressed by Tsuria (see, e.g., Tsuria, 3: 66 - 4:4). Thus, because the problems addressed by Grossman/Tsuria and Picco are distinct and unrelated, there is no suggestion or motivation to combine the references that can be found in the references themselves.

The Office Action recites no particular motivation for the combination. Instead, it is simply stated that such a combination would be "obvious to one of ordinary skill in the art" (see Office Action at p. 4, ll. 3-9). The U.S. Court of Appeals for the Federal Circuit has cautioned against rote invocation of "ordinary skill in the art" by specifically indicating that when an obviousness rejection is made, an examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would invoke the use of such elements in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Merely indicating, as in the present Office Action, that the claimed invention would be obvious to one of ordinary skill in the art is inadequate. *Id.* Instead, what is needed is a showing of motivation, either from the references themselves or the knowledge of those of ordinary skill in the art, for the combination being relied upon. *Id.*

Note further that the recitation of a purported *purpose* for the combination is NOT the same as a motivation for same because the purpose is revealed only by the present invention. In other words, the purpose behind combining Grossman/Tsuria and Picco is suggested solely by hindsight in view of the present method/system in which data sets are downloaded according to user profile information. Accordingly, the present rejections are legally inadequate and should be reversed.

IV. There is no reasonable expectation of success if Picco, where the displaying of the local content is dependent on the availability of the local content space within the compressed digital data stream, is combined with Grossman, where there is no mechanism to identify local content space

Even if the teachings of the cited references were combined, there is no reasonable expectation of success, because in Picco the local content is inserted into the programming data stream *only* when the local content space is identified within the compressed digital data stream (Picco 6: 20-23, 38-40), and thus displaying of local content in Picco is dependent on the availability of the local content space within the compressed digital data stream. There is no indication in Grossman that there is a mechanism to receive, generate, or handle individualized local content such as in Picco. For example, because an ICI is an event that cannot be predicted, there is no time certain at which the local content discussed in Picco could be inserted.

On the other hand, there is no indication that a system in Picco can be adapted to be used to display local content during the ICI as well as or instead of during the programming. On the contrary, the local content provided in Picco depends on identifying a local content space within the compressed digital data stream (Picco, 6: 37-40). Thus, a natural result of the Grossman-Picco combination does not yield the downloading of data sets according to user profile information, the selected data sets representing information elements for display to a user during switching events, as required by the present claims.

V. There is no suggestion or motivation to combine Howe, directed at interactive sessions relating to the content of television broadcasts, with Grossman/Tsuria directed at displaying visual images in response to a channel change

Howe is cited for teaching an interactive transaction session. However, it is questionable whether one of ordinary skill in the art would have realized that such use of sessions could have been adapted for use in the system taught by Grossman. To wit, Grossman is concerned with the display of information during times other than when a television picture is being displayed, i.e., during the delay period between the displays of sequentially displayed channels (Grossman, 3: 46-55). There is no indication in Grossman that the information displayed when the user changes channels is in any way dependent on or related to the content of the television picture. Howe, on the other hand, is concerned with initiating interactive sessions based on the content of a current television broadcast (Howe, 12: 30 et seq.). Thus, one of ordinary skill in the art would not have been motivated to make the combination suggested by the examiner because the references themselves do not suggest such a combination and the problems being addressed therein are not at all similar. For these reasons, the combination of Grossman and Howe references is not

supported and the present rejections should be removed

VI. The rejection of claims 5, 32, and 33 is erroneous, because there is no suggestion or motivation to combine Nathan, directed at recording and reproduction of audiovisual information, with Grossman/Tsuria directed at displaying visual images in response to a channel change.

Although Nathan is cited for teaching the storing of one data set in a buffer and another data set in a memory, wherein the data set in the buffer is replaced by the one in memory after the first data set in the buffer is transmitted for display, a combination of Nathan and Grossman does not satisfy the *Graham* factual inquiry (MPEP 2141), as there is no suggestion or motivation to combine the references (see also MPEP 2143.01). Specifically, Nathan's disclosure relates to home digital audiovisual information recording and reproduction apparatus (Nathan 1:29-30), which allows the user to select and purchase a musical piece (Nathan: 12: 8-19). Thus, Nathan's disclosure is unrelated to concerns such as utilizing the zap time, a problem specific to the field of cable television systems. Grossman/Tsuria, on the other hand, address displaying visual images in response to the determination of a channel change (see, e.g., Grossman 4: 55-61), and are not concerned with enabling a user to acquire and reproduce audiovisual data selections using a television screen and a stereo system. Thus, one of ordinary skill in the art would not have been motivated to make the combination suggested by the examiner because the references themselves do not suggest such a combination and the problems being addressed therein are distinct.

The motivation to combine Grossman/Tsuria and Nathan is suggested solely by hindsight in view of the presently claimed invention, hence, the combination of references is improper.

VII. Claim 28 is Patentable over the combination of Grossman, Picco, Kitsukawa, and Tsuria is improper

Kitsukawa is cited for teaching an interactive transaction system using the Internet. However, it is questionable whether one of ordinary skill in the art would have realized that such use of information elements with interactive elements could have been adapted for use in the system taught by Grossman. To wit, Grossman is concerned with the display of information during times other than when a television picture is being displayed, i.e., during the delay period between the displays of sequentially displayed channels (Grossman et al. 3: 46-55). There is no indication in Grossman that the information displayed when the user changes channels is in any way dependent on or related to the content of the television picture. Kitsukawa, on the other hand, is concerned with displaying information superimposed on a television picture (Kitsukawa et al. 10:43-50). Stated differently, Kitsukawa is concerned with displaying information directly related to the content of the television picture, i.e., providing coupon information for products and

services used in the scenes of television programs (Kitsukawa et al. 10:43-50). Thus, one of ordinary skill in the art would not have been motivated to make the combination suggested by the examiner because the references themselves do not suggest such a combination and the problems being addressed therein are not at all similar. For these reasons, the combination of Grossman and Kitsukawa references is not supported and the present rejections should be removed.

For at least the foregoing reasons, the claims are patentable over the references cited in the Office Action. If there are any additional fees due in connection with this communication, please charge our deposit account no. 19-3140.

Respectfully submitted,

SONNENSCHEIN NATH & ROSENTHAL LLP



Tarek N. Fahmi
Reg. No. 41,402

Dated: December 13, 2005

P.O. Box 061080
Wacker Drive Station
Sears Tower
Chicago, IL 60606-1080
(415) 882-5023